BLAKELY SOKOLOFF TAYLOR & ZAFMAN
A LIMITED LIABILITY PARTNERSHIP INCLUDING LAW CORPORATIONS

1279 OAKMEAD PARKWAY
SUNNYVALE, CALIFORNIA 94085
(408) 720-8300 (Telephone)
(408) 720-8383 (Facsimile)

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Deliver to: Examiner Michael Opsasnick - Art Unit 2655
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From: Jordan M. Becker
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Operator: Julie Arango **Matter:** 03932.P006X
Number of pages including cover sheet: 5
In Re Patent Application of: Michael H. Cohen et al.
Application No.: 09/412,173
Filed: October 4, 1999
For: Method and Apparatus for Optimizing a Spoken Dialog Between a Person and a Machine

Enclosed are the following documents:
[X] Response to Final Office Action (4 pgs.)

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(Rev. 11/23/97)

Attorney Docket No.: 03932.P006X

Patent

#13 Records (E) mail 12/4/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application for:

Michael H. Cohen et al.

Serial No.: 09/412,173

Filing Date: October 4, 1999

For: METHOD AND APPARATUS FOR OPTIMIZING A SPOKEN DIALOG BETWEEN A PERSON AND A MACHINE

Examiner: Opsasnick, M.

Group Art Unit: 2655

which is a continuation-in-part of:

Serial No.: 09/203,155

Filing Date: December 1, 1998

Box AF
Assistant Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO FINAL OFFICE ACTION

Dear Sir:

In response to the Final Office Action mailed on November 18, 2002, please reconsider the present application in view of the following remarks.

Applicants traverse each of the rejections. Applicants maintain all of the arguments set forth in their response to Office Action filed on August 28, 2002. All of those arguments are incorporated into this paper by reference as if fully set forth herein.

Applicants note that in the Final Office Action, the Examiner has essentially cut and pasted the rejections from the previous Office Action and has

made no attempt to substantively rebut any of Applicants' arguments. That omission is quite telling. The Examiner only asserts procedural objections to the manner in which Applicants framed their arguments (Final Office Action, pp. 4-5), and those objections are entirely without merit.

In particular, the Examiner contends that Applicants have argued against the references individually, rather than in combination. Applicants are unable to understand the basis of that assertion. In their last response, Applicants specifically emphasized in numerous instances that the combination of cited references fails to disclose or suggest what is claimed. See generally, for example, Applicants' last response from p. 4 through the middle of page 6, and throughout the response. As just one specific example, Applicants state on p. 5, "From the foregoing, it should be apparent that no combination of Balakrishnan and Imielinski produces or even suggests all of the limitations of the present invention . . . nor does it suggest the claimed invention as a whole" (emphasis both original and added).

In order to address an asserted combination of references for purposes of § 103, one must first ascertain the references' individual teachings (or lack thereof). Only by first examining the references' individual teachings can one ascertain the extent of the references' combined teachings. To refrain from discussing the references' individual teachings at all would be to facilitate the Examiner's conveniently glossing over the deficiencies in their teachings

regarding the alleged combination, which is what the Examiner has done thus far. Again, Applicants' arguments were clearly directed to the combination of cited references, and those arguments are meritorious.

Regarding the Examiner's contention that the Applicants' arguments on pp. 6-8 of the last response do not comply with 37 C.F.R. § 1.111(c), Applicants strongly disagree. Not only did Applicants indicate, in bold type, numerous claim limitations that are not disclosed or suggested by the cited combination, Applicants discussed those claim limitations in detail on the very pages the Examiner contends are non-compliant, as well as throughout the remarks section of the response. Applicants are unable to see how they could have more clearly pointed out the patentable distinctions between the claims and the cited combination. Furthermore, regarding the Examiner's statement that Applicants' arguments "do not clearly point out the patentable novelty", the Examiner is reminded that novelty is not at issue here, since the claims have been rejected under 35 U.S.C. § 103, not under § 102.

Thus, Applicants respectfully request that the Examiner reconsider Applicants' last response, in its entirety, on the merits. Applicants respectfully submit that that response fully overcomes all of the rejections.

For the foregoing reasons, the present applicant is in condition for allowance, and such action is earnestly requested.

If any additional fee is required, please charge Deposit Account No. 02-2666.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: 12/2/02

Jordan M. Becker
Reg. No. 39,602

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1030
(408) 720-8300

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